

REMARKS/ARGUMENTS

Claims 1-11 are pending in the application. Claims 1-11 have been rejected. Claims 1, 3, and 5 have been amended. New claims 12 and 13 have been added. Reconsideration is requested.

Rejections under 35 U.S.C. §103

The Office Action rejected claims 1-11 as unpatentable over U. S. Patent 6,360,360 hereafter, Bates in view of U. S. Patent 6,530,075, hereafter Beadle. Under 35 U.S.C. §104 (c) (1) "Subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title [35 USCS § 102], shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the claimed invention was made, owned by the same person or subject to an obligation of assignment to the same person." Bates was owned by the same person (International Business Machines) that the present application. Because the rejection is under 35 U.S.C. §103(a) and Bates is applied as a 35 U.S.C. §102(e). Therefore, Bates is not prior art and the rejection should be withdrawn.

The Office Action rejected claims 1-11 as unpatentable over Raverdy (U.S. Patent 6,324,619, hereafter "Raverdy") in view of Blake et al (U.S. Patent 5,752,038, hereafter "Beadle"). Raverdy is not even relevant because it does not calculate the cost of each alternative implementation of the component, as required by all of the claims at issue. With respect to claim 1, the office action admits that Raverdy neither teaches nor suggests the claim limitation of instrumenting but does not make the requisite showing of a teaching, motivation, or suggestion for modifying Raverdy that would establish obviousness. Blake does not teach or suggest at least using the cost-related information to estimate a cost for using each of a plurality of explicitly selectable implementations of a component in running the program. Blake analyzes the execution data to determine an optimal placement order for a code segment (see col. 7, lines 47-49). However a code segment is not analogous to alternative implementations of components

as claimed and the analysis of Blake is not of a cost but of the *placement* of the code portion. The claimed invention optimizes the selection of a component based on cost. Blake does not do that.

Claims 2-4 are dependent on claim 1 and are patentable for the above reasons. Claim 5 is a computer-readable counterpart of claim 1 and it and its dependent claims are also patentable for the above reasons. Claim 9 is a computer program counterpart of claim 1 and it and its dependent claims are thus patentable for the above reasons.

For the foregoing reasons, Applicant respectfully requests allowance of the pending claims and that a timely Notice of Allowance be issued in this case.

Respectfully submitted,

Michael J. Buchenhorner
Michael J. Buchenhorner
Reg. No. 33,162

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HOLLAND & KNIGHT LLP
Holland & Knight LLP
701 Brickell Avenue, Suite 3000
Miami, FL 33131
(305) 789-7773 (voice)
(305) 789-7799 (fax)

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I hereby certify that this Amendment and Response to Office Action, and any documents referred to as attached therein, are being deposited with the United States Postal Office with sufficient postage as first-class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450.

Michael J. Buchenhorner
Michael J. Buchenhorner

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